UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
09922066	8/3/2001	Thierry Godel	20706

EXAMINER	
PATEL SUDHAKER	
ART UNIT	**PAPER NUMBER**
1624	16

DATE MAILED:

INTERVIEW SUMMARY

All participants (applicant, applicant's representative, PTO personnel):

(1) PATEL SUDHAKER (3) _____

(2) Kimberly Prior (4) _____

Date of Interview 10/30/03

Type: ☐ Telephonic ☐ Televideo Conference ☐ Personal (copy is given to ☐ applicant ☒ applicant's representative).

Exhibit shown or demonstration conducted: ☐ Yes ☒ No If yes, brief description: _____

Agreement ☐ was reached. ☒ was not reached.

Claim(s) discussed: 1-72

Identification of prior art discussed: None

Description of the general nature of what was agreed to if an agreement was reached, or any other comments:

(1) Applicants will address issues related to [A] Priority [B] new matter [C] 112 issues.

(2) Reply with remarks would be considered by the examiner.

(A fuller description, if necessary, and a copy of the amendments, if available, which the examiner agreed would render the claims allowable must be attached. Also, where no copy of the amendments which would render the claims allowable is available, a summary thereof must be attached.)

☐ It is not necessary for applicant to provide a separate record of the substance of the interview.

Unless the paragraph above has been checked to indicate to the contrary. A FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION IS NOT WAIVED AND MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has are ready been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW.

Examiner Note: You must sign this form unless it is an attachment to another form.

1624

Manual of Patent Examining Procedur , Secti n 713.04 Substance of Inte / must Be Made f Record

Except as otherwise provided, a complete written statement as to the substance of any face-to-face or telephone interview with regard to an application must be made of record in the application, whether or not an agreement with the examiner was reached at the interview.

§1.133 Interviews

* * * * *

(b) In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office action as specified in §§ 1.111 and 1.135. (35 U.S.C. 132)

§ 1.2. Business to be transacted in writing. All business with the Patent or Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

The action of the Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews.

It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, unless the examiner indicates he or she will do so. It is the examiner's responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability.

Examiners must complete a two-sheet carbon interleaf Interview Summary Form for each interview held after January 1, 1978 where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks in neat handwritten form using a ball point pen. Discussions regarding only procedural matters, directed solely to restriction requirements for which interview recordation is otherwise provided for in Section 812.01 of the Manual of Patent Examining Procedure, pointing out typographical errors or unreadable script in Office actions or the like, or resulting in an examiner's amendment that fully sets forth the agreement are excluded from the interview recordation procedures below.

The Interview Summary Form shall be given an appropriate paper number, placed in the right hand portion of the file, and listed on the "Contents" list on the file wrapper. In a personal interview, the duplicate copy of the Form is removed and given to the applicant (or attorney or agent) at the conclusion of the interview. In the case of a telephonic interview, the copy is mailed to the applicant's correspondence address either with or prior to the next official communication.

The Form provides for recordation of the following information:

- Application Number of the application
- Name of applicant
- Name of examiner
- Date of interview
- Type of interview (personal or telephonic)
- Name of participant(s)) (applicant, attorney or agent, etc.)
- An indication whether or not an exhibit was shown or a demonstration conducted
- An identification of the claims discussed
- An identification of the specific prior art discussed
- An indication whether an agreement was reached and if so, a description of the general nature of the agreement (may be by attachment of a copy of amendments or claims agreed as being allowable). (Agreements as to allowability are tentative and do not restrict further action by the examiner to the contrary.)
- The signature of the examiner who conducted the interview
- Names of other Patent and Trademark Office personnei present.

The Form also contains a statement reminding the applicant of his responsibility to record the substance of the interview.

It is desireable that the examiner orally remind the applicant of his obligation to record the substance of the interview in each case unless both applicant and examiner agree that the examiner will record same. Where the examiner agrees to record the substance of the interview, or when it is adequately recorded on the Form or in an attachment to the Form, the examiner should check a box at the bottom of the Form informing the applicant that he need not supplement the Form by submitting a separate record of the substance of the interview.

It should be noted, however, that the Interview Summary Form witl not normally be considered a complete and proper recordation of the interview unless it includes, or is supplemented bv the applicant or the examiner to include, all of the applicable items required below concerning the substance of the interview:

A complete and proper recordation of the substance of any interview should include at least the following applicable items:

1) A brief description of the nature of any exhibit shown or any demonstration conducted,
2) an identification of the claims discussed,
3) an identification of specific prior art discussed,
4) an identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary Form completed by the examiner,
5) a brief identification of the general thrust of the principal arguments presented to the examiner. The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments made to the examiner can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he feels were or might be persuasive to the examiner,
6) a general indication of any other pertinent matters discussed, and
7) if appropriate, the general results or outcome of the interview unless already described in the Interview Summary Form completed by the examiner.

Examiners are expected to carefully review the applicant's record of the substance of an interview. If the record is not complete or accurate, the examiner will give the applicant one month from the date of the notifying letter to complete the reply and thereby avoid abandonment of the application (37 CFR 1.135(c)).

Examiner to Check for Accuracy

Applicant's summary of what took place at the interview should be carefully checked to determine the accuracy of any argument or statement attributed to the examiner during the interview. If there is an inaccuracy and it bears directly on the question of patentability, it should be pointed out in the next Office letter. If the claims are allowable for other reasons of record, the examiner should send a letter setting forth his or her version of the statement attributed to him. If the record is complete and accurate, the examiner should place the indication "Interview record OK" on the paper recording the substance of the interview along with the date and the examiner's initials.

DETAILED ACTION

I. *Election/Restriction*

Applicant's election with traverse of species with traverse in Paper No. 9 dated 4/29/03 is acknowledged. The traversal is on the ground(s) that the Office has not shown any serious burden for including other definitions of R,R2, R3, R3', R4 and R4'. This is not found persuasive because examiner found prior art(s) and reference(s) which claim similar subject matter as claimed herein. Additionally, variables when considered simultaneously with other components e.g. R1 and X will provide multiples of species which are difficult to examine thoroughly on individual basis within the time at disposal to examiner for a patent. Although, the main core is 4-phenyl-pyridine, variables R1 and X will give either same or different main class(es), but multiples of subclasses as per the U. S. Patent classification system in the following manner:

Although the main core for this application is 4-phenyl pyridine which falls in class 546, when the R1 component as piperazine, the main class is 544 which supersedes class 546, and the search for class 546 is not equivalent to search for class 544.

In addition to the species as described in earlier Office communication paper # 8 dated 1/29/03, Examiner has also examined the species of Example 1 wherein following hits were obtained.

Class 544, subclasses 357,360----- hits generated are :2600;

Class 514, subclasses 252.12,252.13, 277,343.....hits generated are :1410, and a total of these two classes is more than 4000.

The number of hits generated for some of the other structures are as follows:

Example 15 wherein R1 is pyrrole or its derivatives will generate: 863;
Example 5 wherein R1 is pyridine or its partially hydrogenated form: 410;
Example 40 wherein R1 is 1,2 oxazole: 356;
Example 62 wherein R1 is 1,2,4 oxadiazole: 225;
Example 93 wherein R1 is 1,2 thiazole: 590;
Example 101 wherein R1 is 1,24 triazole: 479.

The components R/R2; R4/R4' can also form fusion, and the bicyclic rings formed are not chemical equivalent to phenyl rings.

Additionally, the bridges as represented by components X, will generated multiples of different compounds which are different from each other.

Therefore, for each main class, the utility class will add more search. It is this combined through additional search which is time consuming, and therefore burdensome to examiner.

The restriction requirement is still deemed proper for the reasons stated in earlier Office communication paper # 8 dated 1/29/03 and also for the additional reasons stated earlier, and is therefore made FINAL.

II. Rejections withdrawn:

Applicants' Declaration under 37 CFR 1.132 dated 4/29/03 is acknowledged. Based on this declaration the rejections made under 35 U.S.C. 102(e) has been withdrawn.

Applicants arguments and remarks are sufficient to overcome the rejections made under 35 U.S.C.112 para second.

Upon further review and reconsideration, this application is not ready for allowance at this stage for following rejections.

New Rejections:

III.A. ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-9,13-15,35,39-45,50-52,69 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6303790. Although the conflicting claims are not identical, they are not patentably distinct from each other because ref.'790 claim 1 encompasses the subject matter claimed herein in the following manner:

R1= aryl optionally substituted with alkyl,alkoxy,halogen,CF3 =Instant phenyl ring with (R)n and R2 variables;
R4 =R1 =H/alkyl, cyclic tr.-amine;
X = X =-CONR8 or -NR8CO-;
R3/R3' =R3/R3'=H/alkyl and fusion;
R2/R2' =R4/R4'=H/halogen/CF3/alkoxy & fusion.

IIIB. Claims 1-9,13-15,35,39-45,50-52,69 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No.6297375. Although the conflicting claims are not identical, they are not

patentably distinct from each other because ref.'375 claim 1 encompasses the subject matter claimed herein in the following manner:

(R1)p	=Instant (R)n= Halogen/H; R =R2 = lower alkyl/ alkoxy/ halogen/CF3;
R4	=R1 =H, cyclis tr.-amine;
X	= X =CONR8/ -NR8CO-
/(CH2)-	O/(CH2)pNR8;
R3/R3'	=R3/R3'= alone or with fusion;
R2/R2'	=R4/R4'=H/halogen/CF3/alkoxy & fusion;
R1/R	=R2/R forming fusion.

IV. *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,3-9,13-15,35,39-45,50-52,69 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S.P. 4745123 also cited as Chemical Abstract DN 108:186578.Instant compounds read onto the ref. '123 in following way:

Reference U.S.P. 4745123:

R4(see col.3 lines 7-21 & 52-54) = Phenyl/substituted phenyl with halogen,alkyl,alkoxy;

R3=COR'R" & R'=H/alkyl;R"= substituted phenylalkyl =X = COCH2- substituted phenyl;

H =R1;

See also compounds 7 and 8 of the reaction scheme in column 6 lines 34-40, and also compound 46 in Table D columns 13/14 wherein R3 = CONHCH2-Phenyl, and compounds #33,34, 19 which show mono and di substitutions on to phenyl ring.

Additionally the compound represented by CAS RN # 114120-64-8 (= 3-pyridine carboxamide, 4-phenyl-N-(phenyl methyl) is encompassed by instant claim 1.

VI. *Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 68 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for headache, headache, does not reasonably provide enablement for Alzheimer's disease, attenuation of morphine withdrawal, cardiovascular changes, respiratory and other diseases as recited herein. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with these claims.

In evaluating the enablement question, several factors are to be considered. Note In re Wands, 8 USPQ2d 1400 and Ex parte Forman, 230 USPQ 546. The factors include:

1). The nature of the invention, 2). the state of the prior art, 3). the predictability or lack thereof in the art, 4). the amount of direction or guidance present, 5). the presence or absence of working examples, 6). the breadth of the claims, and 7). the quantity of experimentation needed.

1) The nature of the invention: The method of use claim is drawn in part to alleviating the symptoms of patient having a disease state treatable by modulation of NK-1 receptor antagonists. The diseases include inflammation, HIV infections, morphine withdrawal symptoms,, Alzheimer's disease, cardiovascular changes, multiple sclerosis, oedema, CNS disorders and others.

2) The state of the prior art: There are no known compounds of similar structure which have been demonstrated to treat Alzheimer's disease nor is there any compound that can be used to treat drug addiction, drug and alcohol withdrawal symptoms by a single compound. For example, the notion that a compound could be effective against chemical substance abuse or withdrawal caused by the cessation of intake of chemical substances in general is absolutely contrary to our current understanding of how chemical dependencies operate. There is not, and probably never will be, a pharmacological treatment for "chemical substance abuse or withdrawal caused by the cessation of intake of chemical substances" generally. That is because "chemical substance/drug abuse or withdrawal caused by the cessation of intake of chemical substances" is not a single disease or cluster of related disorders, but in fact,

a collection with relatively little in common. Addiction to barbiturates, alcohol, cocaine, opiates, amphetamines, benzodiazepines, nicotine, etc. all involve different parts of the CNS system; different receptors in the body. For example, cocaine binds at the dopamine reuptake transmitter. Heroin addiction, for example, arises from binding at the opiate receptors, cigarette addiction from some interaction at the nicotinic acid receptors, many tranquilizers involve the benzodiazepine receptor, alcohol involves yet another system, etc. All attempts to find an pharmaceutical to treat chemical addictions generally have thus failed. Alzheimer's disease is treated, albeit not successfully, using acetylcholine esterase inhibitors and Parkinson's disease using dopamine receptors. A disease in the central or peripheral system is not a single disease but embraces disease that are not related or even "opposites"; headache, arthritis and asthma are covered and diseases that are not treatable pharmacologically are also embraced (e.g. Parkinson's disease, Crohn's disease, psychosis).

3) The predictability or lack thereof in the art: It is presumed in the treatment of the diseases claimed herein there is a way of identifying any and all of the diseases which are responsive to the activity of nicotinic ACh receptor modulators. There is no evidence of record which would enable the skilled artisan in the identification of the diseases treatable with the disorders claimed herein.

4) The amount of direction or guidance present and 5) the presence or absence of working examples: There are no doses present for treatment of the disorders recited.

6) The breadth of the claims: The claims are drawn to disorders that are not related and whose treatment is unknown.

7) The quantity of experimentation needed would be an undue burden to one skilled in the pharmaceutical arts since there is inadequate guidance given to the skilled artisan for the many reasons stated above.

Following reference is cited to show the state of art related to Alzheimer's disease:

Coyle et al(Science Vol.219, pages 1184-1190(1983)) cites in the summary that:" These cholinergic neurons provide widespread innervation of the cerebral cortex and related structures and appear to play an important role in cognitive functions, especially memory". The authors conclude (see page 1189) that:" The identification of a transmitter-specific pathway selectively affected in a major form of dementia is an important step in the design of diagnostic studies, investigations of pathogenic mechanisms, and the development of therapeutic approaches to these debilitating neuropsychiatric disorders".

Specification remains silent about various assays and test methods for compounds of Formula (I) which are expected to exhibit NK-1, substance P antagonistic activity.

Claim 68 as recited includes: " Disease state treatable by modulation of NK-1 receptor antagoniosts".

Thus, factors such as "sufficient working examples", "the level of skill in the art" and "predictability", etc. have been demonstrated to be sufficiently lacking in the instant case for the instant method claim.

Despite intensive efforts, pharmaceutical science has been unable to find a way of getting a single compound for a method of alleviating the symptoms of any and all diseases. Under such circumstances, it is proper for the PTO to require evidence that such an unprecedented feat has been achieved, In re Ferens, 163 USPQ 609. No such evidence has been presented in this case. The failure of skilled scientists to achieve a goal is substantial evidence that achieving such a goal is beyond the skill of practitioners in that art, Genentech vs. Novo Nordisk, 42 USPQ 2nd 1001, 1006.All available drug for treating Alzheimer's disease or Parkinsons' disease could be used in a limited way, and provide protection mostly with side effects.

VII. *Claim Objections*

Claims 10-12,16-34,36-38,46-49,53-67 are objected to because of the following informalities: They consist of n on elected subject matter. Appropriate correction is required.

VIII. *Conclusion*

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sudhaker Patel, D.Sc. Tech., whose telephone number is (703) 308 4709. The examiner can normally be reached on Monday thru' Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by the phone are unsuccessful, the examiner's supervisor, Dr. Mukund Shah can be reached at (703) 308 4716 or Sr. Examiner Mr. Richard Raymond at (703)308 4523.A facsimile center has been established for Group 1600. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier numbers for accessing the facsimile machine are (703) 308-4556 or (703) 305-3592.Any inquiry of general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308 1235.

Mukund Shah

sp

Supervisory Patent Examiner

May 18, 2003

Art Unit 1624